

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/987,362
Attorney Docket No. Q67261

REMARKS

I. Introduction

Pending claims 1-4, 7-14 and 17-28 have been examined. The Examiner withdraws the allowability of claims 9, 16, 18, 20-21 and 23-27 in view of newly applied references Nzei, U.S. Patent No. 4,932,644 (hereinafter "Nzei") and Egashira et al., U.S. Patent No. 5,135,905 (hereinafter "Egashira").

The Examiner rejects claims 1-4, 8-14 and 20-28. Specifically, claims 1-4 and 28 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Taylor, Jr. et al., U.S. Patent No. 6,365,305 (hereinafter "Taylor") in view of Nzei; claims 8-14 and 22-25 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Taylor in view of Nzei, as applied to claim 1, and further in view of Egashira; claims 20-21 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Taylor in view of Nzei and Egashira, as applied to claim 11, and further in view of newly applied Komori et al., U.S. Patent No. 3,919,972 (hereinafter "Komori"); and claims 26-27 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Taylor, in view of Nzei and Egashira, as applied to claim 11, and further in view of newly applied Hirano et al., U.S. Patent No. 6,246,466 (hereinafter "Hirano"). Additionally, the Examiner objects to claims 7 and 17-19.

Applicant traverses the rejections of claims 1-4, 8-14 and 20-28 as follows.

II. Allowable Subject Matter

As noted above, the indicated allowability of claims 9, 16, 18, 20-21 and 23-27 has been withdrawn in view of the newly applied references Nzei and Egashira. However, the Examiner

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/987,362
Attorney Docket No. Q67261

acknowledges that objected-to claims 7, 17 and 19 contain allowable subject matter. In particular, the Examiner indicates that these claims would be allowable (and their objections overcome) if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Since Applicant traverses the rejections of independent claims 1 and 11, for at least the reasons set forth below, Applicant withholds rewriting claims 7, 17 and 19 in independent form at this time.

Additionally, in response to the Examiner's statement of reasons for allowance, as set forth on page 7 of the Office Action, Applicant respectfully submits that these reasons are exemplary in nature, and that each of claims 7, 17 and 19 is allowable, as a whole, based on the entirety of the features recited therein.

III. Claim Rejections -- 35 U.S.C. § 103(a)

A. *Claims 1-4 and 28 stand rejected under § 103(a) as allegedly being unpatentable over Taylor in view of Nzei*

Claim 1

Claim 1 recites, *inter alia*, "a package comprising at least one set of stacked recording media including an image-receiving sheet having an image-receiving layer which is fed to a recording medium holding member and a plurality of transfer sheets each having a toner layer which are successively fed to the recording medium holding member so that the toner layer of each transfer sheet may be brought into contact with the image-receiving layer of the image-receiving sheet, said image-receiving sheet and said transfer sheets being stacked in order of feed

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/987,362
Attorney Docket No. Q67261

to the recording medium holding member". The Examiner alleges that Taylor discloses these features at col. 29, lines 53-60 and col. 34, lines 27-35.

To the contrary, Taylor merely describes the manual loading of components into a cassette, and thus does not address the exemplary problems set forth in Applicant's Specification at page 3, line 13 to page 4, line 3. Indeed, Taylor notes that color donor sheets and a receiver element are placed in a cassette (Taylor: col. 34, lines 27-35). This manually-loaded cassette does not correspond to the package recited in claim 1.

The recited package comprises sets of recording media which are stacked in order of feed to a recording medium holding member (claim 1). Thus, after the package is opened, the sets of stacked recording media can be disposed in a recording apparatus one set at a time (Applicant's Specification: page 4, lines 20-25.). Consequently, by use of the recited package, there is no need to manually handle and stack the recording media one by one into a recording apparatus (*Id.*).

Conversely, Taylor fails to teach or suggest any package, let alone a package different from the conventional packages described in Applicant's Specification at page 2, lines 4-18. Likewise, Nzei also fails to teach or suggest any such package.

For at least these exemplary reasons, claim 1 is not rendered obvious by a reasonable combination, if any, of Taylor and Nzei.

Claims 2-4

Claims 2-4 are patentable at least by virtue of their dependency, as well as the additional features recited therein.

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/987,362
Attorney Docket No. Q67261

For example and not by way of limitation, claim 3 recites a package that includes "a plurality of said sets of stacked recording media". As noted above, neither Taylor nor Nzei teaches or suggests a package including a set of stacked recording media. Consequently, Taylor and Nzei (either alone or in combination) fail to teach and cannot possibly suggest a package that includes "a plurality of said sets of stacked recording media", as recited in claim 3.

Claim 28

Claim 28 recites, *inter alia*, "at least one set of preset recording media stacked in order of feed to a recording medium holding member". Neither Taylor nor Nzei (alone or in combination) teaches or suggests any set of stacked and ordered preset recording media. Consequently, claim 28 is patentable based on a rationale analogous to that provided above for claim 1.

B. Claims 8-14 and 22-25 stand rejected under § 103(a) as allegedly being unpatentable over Taylor in view of Nzei, and further in view of Egashira

Claim 11

Claim 11 recites, *inter alia*, "a feed cassette comprising a cassette body and preset recording-media containing a set of stacked recording media including an image-receiving sheet having an image-receiving layer which is fed to a recording medium holding member and a plurality of transfer sheets each having a toner layer which are successively fed to the recording medium holding member so that the toner layer of each transfer sheet may be brought into contact with the image-receiving layer of the image-receiving sheet, said image-receiving sheet and said transfer sheets being stacked in an order of feeding to the recording medium holding member".

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/987,362
Attorney Docket No. Q67261

As noted above, neither Taylor nor Nzei (alone or in combination) teaches or suggests any set of stacked and ordered preset recording media including an image-receiving sheet and a plurality of transfer sheets. Likewise, Egashira fails to teach or suggest any set of stacked and ordered preset recording media including an image-receiving sheet and a plurality of transfer sheets. Consequently, claim 11 is patentable based on a rationale analogous to that provided above for claim 1.

Claims 8-10, 12-14 and 22-25

Claims 8-10, 12-14 and 22-25 are patentable at least by virtue of their dependency, as well as the additional features recited therein.

For example and not by way of limitation, claim 12 recites a feed cassette that includes preset recording media containing "a plurality of the sets of stacked recording media". As noted above, neither Taylor nor Nzei teaches or suggests a feed cassette including a preset set of stacked recording media. Furthermore, Egashira also fails to teach or suggest a preset set of stacked recording media. Consequently, Taylor, Nzei and Egashira (either alone or in combination) fail to teach and cannot possibly suggest a feed cassette that includes preset recording media containing "a plurality of the sets of stacked recording media", as recited in claim 3.

Furthermore, claim 22 recites that "said cassette body is made of metal". Thus, for example, any static electricity generated by friction among the stacked recording media during transportation is not accumulated because it is allowed to escape into the metallic cassette body

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/987,362
Attorney Docket No. Q67261

(Applicant's Specification: page 12, lines 8-13). Taylor, Nzei and Egashira (alone or in combination) fail to teach or suggest a cassette body being made of metal.

C. Claims 20-21 stand rejected under § 103(a) as allegedly being unpatentable over Taylor in view of Nzei and Egashira, and further in view of Komori

Komori fails to make up for the deficiencies of Taylor, Nzei and Egashira, as noted above for claim 11. Consequently, claims 20 and 21 are patentable over a reasonable combination, if any, of Taylor, Nzei, Egashira and Komori at least by virtue of their dependency.

D. Claims 26-27 stand rejected under § 103(a) as allegedly being unpatentable over Taylor in view of Nzei and Egashira, and further in view of Hirano

Hirano fails to make up for the deficiencies of Taylor, Nzei and Egashira, as noted above for claim 11. Consequently, claims 26 and 27 are patentable over a reasonable combination, if any, of Taylor, Nzei, Egashira and Hirano at least by virtue of their dependency.

IV. Claim Objections

The Examiner objects to claim 18 under 37 C.F.R. § 1.75 as allegedly being a substantial duplicate of claim 17, noting that "when two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim" (see MPEP § 706.03(k)). In particular, the Examiner alleges that "basically, both claims 17 and 18 recite the pickup mechanism being applied to the recording media on the side opposite to the side where the interleaving sheets extend outward from the stack".

Applicant respectfully disagrees with the Examiner's allegation. While this aspect of claim 17 might be shared by claim 18 (because of the limitation in claim 11 that "said

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/987,362
Attorney Docket No. Q67261

interleaving sheet extends outward from at least one side of said set of recording media"), claim 18 is different from claim 17, for example, in that it also requires that "said recording media stick out from the side of said interleaving sheets where a pickup mechanism of a recording apparatus is applied". It may assist the Examiner's understanding to consider the exemplary arrangement of sheets as illustrated in Fig. 28 as compared to the exemplary arrangement of sheets as illustrated in Fig. 30.

For at least these exemplary reasons, Applicant respectfully requests that the Examiner withdraw the objection to claim 18.

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/987,362
Attorney Docket No. Q67261

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Billy Carter Raulerson
Registration No. 52,156

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: October 27, 2003